REMARKS

Reconsideration of the rejections set forth in the Office action dated 10/14/2003 is respectfully requested under the provisions of 37 CFR §1.111(b).

Included herewith is a petition for a one month extension of time and authorization to pay the fee from Deposit Account 24-0025.

Claims 1-8 are pending.

Claims 1-8 stand rejected.

Claims 1, 3, 5, and 7 were amended to make more definite and to include the clarification that the processing rule embodies information flow knowledge between the loaded document and other of said plurality of personal documents. This clarification is supported in the instant application at page 2, lines 5-7; page 6, line 16-18; and page 8, lines 5-6.

35 USC § 102

Claims 1, 3, and 5 under 35 U.S.C. § 102(b) as being anticipated by Unger (US 5,721,910). Anticipation under 35 U.S.C. § 102 requires that each and every claim limitation be disclosed by the applied reference. In fact, as stated in MPEP 2131, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim," citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). In the context of court review of a defense to infringement on the grounds that a patent was invalid due to lack of novelty under 35 U.S.C. § 102, the Federal Circuit has said, "[w]hen the defense of lack of novelty is based on a printed publication that is asserted to describe the same invention, a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device." C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1349, 48 USPQ2d 1225, 1229-30 (Fed. Cir. 1998). Applying that standard to the subject application, to make a prima facie case of anticipation, the Examiner must show that the Unger reference describes all of the elements of claims 1, 3, 5 and 7, arranged as in those

claims. As the MPEP further notes, "[t]he elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required," citing In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

It is respectfully submitted that the Unger reference does not teach each and every claim limitation of currently amended claims 1, 3, 5, and 7 as arranged in those claims, and therefore cannot anticipate the current claims of the instant application.

The claim limitations of the subject invention.

Independent, currently amended claim 1 of the present invention is directed to a computer-implemented method that requires

> A computer-implemented method for managing a plurality of personal documents, comprising:
> loading one of the plurality of personal documents into storage, said loaded document having a category;
> determining the document category;
> receiving at least one processing rule, wherein the rule is associated with the document category, and wherein said processing rule embodies information flow knowledge between said loaded document and other of said plurality of personal documents; and
> processing said loaded document according to the processing rule.

In currently amended claim 1, the "document category" relates to the function of the document (see page 5 lines 2-9). The determination of the document category can be accomplished by evaluating characteristics of the document including such characteristics as the shape of the document, particular types of data on the document (such as account number or logo), pattern or format of the document (page 5, line 10 – page 6, line 4). Thus for example, the document can be categorized as a bill, an invoice, a receipt, a bank statement, a brokerage statement, a tax return, a product warranty, or a check (page 5, lines 3-6). Although information can be extracted from the categorized document, it is the document type that is categorized, not the information contained within the document.

Once the document is categorized, it is processed using the processing rule for the document category. The processing rule embodies information flow knowledge between

the loaded document and other personal documents (page 2, lines 5-7; page 6, line 16-18; and page 8, lines 5-6).

Independent currently amended claim 3, directed to a computer system, independent currently amended claim 5, directed to a computer program, and independent currently amended claim 7, directed to a downloaded computer program, have limitations and meaning similar to claim 1. Thus, the discussion below, while referring to independent claim 1, applies equally to claims 3, 5, and 7.

Discussion of the teachings of the Unger reference.

The Unger reference discloses a multi-dimensional database that models a business or scientific or technical body of work (U: col. 1, lines 8-11). Unger's invention analyzes the technical information contained within a document (such as a patent) and then classifies this technical information. Unger analyzes the technical content of each patent or technical document with respect to a pre-defined model of the scientific or business discipline (U: col. 4, lines 32-44; col. 6, lines 60-67) "to identify and categorize documents to fit a pre-defined matrix of technical categories" (U: col. 7, lines 1-5). The categorization can then be used to identify trends and discontinuities in the research efforts represented by the technology in the underlying technical documents.

Unger does not teach each and every claim limitation of currently amended claims 1, 3, 5, and 7 as arranged in those claims because nothing in Unger teaches a processing rule that embodies information flow knowledge between a loaded personal document and other personal documents.

II. Rejections under 35 USC §103

Claim 7 stands rejected under 35 USC § 103(a) as being unpatentable over Unger. Claim 7 has been amended to more clearly claim a downloaded computer program similar to the computer program product of claim 5.

Having addressed the differences between Unger and the instant application, applicant believes currently amended **claims 1, 3, 5, and 7** are patentable because the Examiner would need to provide one or more references that were available to the

inventor and that teach a suggestion to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

The problem addressed by Unger is that of analyzing technical content of documents such as patents and other scientific literature and of categorizing the information of these documents to identify trends and discontinuities in the overall patterns of research efforts reflected by the technical content of these documents (U: col. 1, line 17 – col. 2, line 10).

Unger does not teach or suggest the use of personal documents (such as bills, invoices etc. see page 5, lines 3-6 of the instant application), or processing rules that embody information flow knowledge between documents (page 8, lines 5-6 of the instant application).

Claims 1, 3, 5 and 7 are patentable over Unger because nothing in Unger would teach a suggestion that Unger's techniques would be applicable to personal documents, or teach a suggestion to include rules that embody information flow between documents. Hence claims 1, 3, 5 and 7 are patentable.

Claims 2, 4, 6, and 8 are rejected under 35 USC 103(a) as being unpatenable over Unger in view of MacPhail.

Claims 2, 4, 6, and 8 are patentable over Unger in view of MacPhail because nothing in Unger or MacPhail, separately or combined would teach a suggestion that Unger's and or MacPhail's techniques would be applicable to personal documents, or teach a suggestion to include rules that embody information flow between documents.

Claims 2, 4, 6 and 8 depend on and further limit claims 1, 3, 5, and 7 that are patentable and so are also patentable.
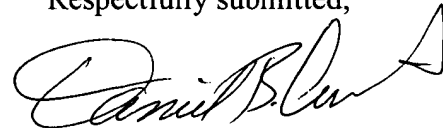
Since all rejections, objections and requirements contained in the outstanding official action have been fully answered or traversed and shown to be inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 CFR §1.111(b) and such reconsideration is respectfully requested. Upon

reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

Should any additional issues remain, or if I can be of any additional assistance, please do not hesitate to contact me at (650) 812-4259.

Respectfully submitted,

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